

Remarks

Applicants have amended claims 12, 25, 28, 32, 34 and 35 as shown above. The amendment in claim 12 and the similar amendments made in claims 25 and 35 align these claims with the text at paragraph 0026 on page 7. This amendment should not affect the allowable status of these claims. The remaining amendments rewrite claims 28, 32 and 34 in independent form (as recommended in the Final Rejection) including all of the limitations of the base claim and any intervening claims. Claim 35 has been made dependent on claim 34 to accomplish the same thing. Following entry of this amendment, claims 1, 2, 4 and 6-37 will be pending in this application.

Rejection of claims 1, 2, 6 to 8, 10, 13 to 23, 27, 29 to 31, 36 and 37 under 35 U.S.C. §102 and §103

Claims 1, 2, 6 to 8, 10, 13 to 23, 27, 29 to 31, 36 and 37 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative under 35 U.S.C. §103(a) as obvious U.S. Patent No. 4,393,121 (Tobias et al.), on grounds, *inter alia*, that:

"The rationale for this rejection is consistent with that noted in the previous office action. While claim 1 has been amended to exclude the term "about", it remains a modifying term in the prior art. Thus "about 48" as found in Tobias et al. is given a degree of tolerance and allows for concentrations slightly about 48. With this in mind one can consider the degree to tolerance given to the limit "about 48" as anticipating 50.¹

"On the other hand, the Examiner also maintains that the difference between "about 48" and 50 is close enough that one having ordinary skill in the art would have expected them to have the same properties. Applicants traverse this position as an inappropriate standard for obviousness; however, their attention is drawn to MPEP 2144.05 I. which notes that this is, in fact, a proper consideration for obviousness." (see the Final Rejection at page 2, paragraph 2).

¹ See in re Ayers, 68 USPQ 109 in which "at least about 10%" was held to be anticipated by "about 8%".

Reconsideration is requested. *In re Ayers* involved a situation in which both the claim and the reference used the modifier “about”. That is not the case here. Applicant’s rejected claims recite that “the polyester resin comprises between 50 and 75 weight percent isophthalic acid” whereas Tobias et al. say at col. 1, lines 46-49 that “The amount of isophthalic acid component used is between about 40 weight percent and about 48 weight percent” These ranges do not overlap and do not share endpoints.

Note in addition that Tobias et al. use two significant figures for all the upper and lower limits they recite at col. 1, lines 31-53, including the isophthalic acid upper limit:

Component	Text Citation	Lower Limit	Upper Limit
Cyclohexanedimethanol	col. 1, lines 30-33	about 10	about 20
Neopentyl Glycol	col. 1, lines 34-37	about 12	about 16
1,3-Butanediol or 1,2-Propanediol	col. 1, lines 38-42	about 12	about 16
Isophthalic Acid (alone or mixed with phthalic anhydride)	col. 1, lines 43-49	about 40	about 48
Adipic Acid	col. 1, lines 50-53	10	about 16

Tobias et al.’s patent claims are even more precise (see, e.g., claims 1, 3 and 6, each of which recites resin “based upon 10-20 weight percent cyclohexanedimethanol, 10-16 weight percent adipic acid, 12-16 weight percent neopentyl glycol, 12-16 weight percent propylene glycol or butanediol, and 40-48 weight percent isophthalic acid component”). A person having ordinary skill in the art would not regard Tobias et al.’s “about 12 to about 48” range or Tobias et al.’s “about 48” upper limit as disclosing or suggesting any part of applicants’ recited “between 50 and 75 weight percent” range.

The Final Rejection relies on MPEP §2144.05 I, which is entitled “OVERLAP OF RANGES”. The cases cited in that section all involve claims and references containing range endpoints that actually overlap or abut one another, and not a claimed range having

no points within or abutting the range recited in the reference. The present situation accordingly does not involve *prima facie* obviousness under MPEP §2144.05 I. Moreover, whether or not *prima facie* obviousness is established (and applicants do not agree that it has), applicants may as permitted under MPEP §2144.05 III rebut *prima facie* obviousness by showing that the art, in any material respect, teaches away from the claimed invention. Applicants have pointed out that:

"separately-cited U.S. Patent No. 5,739,204 (Piana, discussed below) recites several desired properties for polyester protective coatings (see e.g., col. 1, lines 15-20), and says at col. 1, lines 20-21 that "It is difficult to achieve an optimum for all of these properties, as the improvement of one property is in most cases at the expense of the others." Piana also says at col. 1, lines 29-33 that "The hardness can be achieved, for example, by the incorporation of a high proportion of cyclic, in particular aromatic, dicarboxylic acids into the polyester. However, this causes the protective coatings to become brittle and fragile." This provides a further reason why a person having ordinary skill in the art who reviewed Tobias et al. would not use more than Tobias et al.'s recited "about 48" upper limit for the amount of isophthalic acid." (see applicants' August 9, 2007 Amendment at page 12).

In response to that argument, the Final Rejection asserted that

"Reference to the teachings in Piana is not persuasive in establishing any unobviousness, again because the difference between the prior art and that claimed is such that one would not expect a difference in properties. Again note that the prior art results in the same level of hardness as the claimed composition." (see the Final Rejection at page 2, paragraph 2)

The issue is not merely hardness but also brittleness and fragility. Piana does not say to keep adding ever-higher amounts of aromatic dicarboxylic acid while only monitoring hardness. Piana says that incorporation of a high proportion of aromatic dicarboxylic acids "causes the protective coatings to become brittle and fragile". Tobias et al. say that the isophthalic acid amount should be about 40 to about 48 weight percent". A person having

ordinary skill in the art, guided by these statements and not having had the benefit of applicants' disclosure, would not use more isophthalic acid than Tobias et al. say could be used. The appropriate standard is not whether one skilled in the art "would have expected" the claimed compositions and the cited Tobias et al. compositions "to have the same properties". MPEP §2141.02 says that "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious" (emphasis in original). MPEP §2141.02 also says that "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (emphasis in original). The Final Rejection should not substitute its own line of reasoning for the contrary statements made by actual workers in the field. Applicants thus request withdrawal of the §§102(b)/103(a) rejection over Tobias et al.

Rejection of claims 1, 2, 4, 8, 10, 13 to 15, 19 to 23

27, 31, 33, 36 and 37 under 35 U.S.C. §103

Claims 1, 2, 4, 8, 10, 13 to 15, 19 to 23, 27, 31, 33, 36 and 37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Piana, on grounds that:

"This rejection relies on the rationale of record. Applicants' traversal is not persuasive since, as noted above, MPEP 2144.05 supports the Examiner's position of obviousness. The fact that this example is a comparative example does not take away from the this position of obviousness." (see the Final Rejection at page 2, paragraph 3).

Reconsideration is requested. The compositions in Piana's working Examples 1-8 do not contain asymmetric diols. Piana does not discuss diol symmetry or distinguish between symmetric and asymmetric diols. A person having ordinary skill in the art who reviewed Piana would have no basis for making a substrate coated with a polyester resin coating composition formed "using polyols comprising at least one symmetric diol in an amount greater than 50 weight percent based on the total weight of polyols and at least one

asymmetric diol in an amount greater than 20 weight percent based on the total weight of polyols” as recited in applicants’ rejected claims. The cited composition in Piana’s Comparative Example A10 does happen to contain a symmetric diol and an asymmetric diol, but the asymmetric diol amount is less than that claimed by applicant.

Note in addition that Piana does not supply any weathering data for cured coatings made from Comparative Example A10, but does provide gloss measurements. The Comparative Example A10 cured coating exhibits the lowest gloss values shown in Table 4 and on that basis alone appears to be Piana’s worst cured coating.

Moreover, Piana’s Comparative Example A10 composition does not contain any 1,3-propanediol. Piana says that 1,3-propanediol is both an “essential” and a “critical” ingredient (see e.g., col. 4, lines 8-14) and that 1,3-propanediol “combines in a favorable manner the properties of hardness and softness, which results in the outstanding properties of the coating material under consideration” (see e.g., col. 3, lines 33-36). In view of Piana’s statements that 1,3-propanediol was both essential and critical, a person having ordinary skill in the art would have no motivation to make Piana’s Comparative Example A10 coating composition, let alone to modify it by increasing the amount of asymmetric diol. As noted above, MPEP §2141.02 says that “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention”. The Final Rejection has not explained why a person having ordinary skill in the art would select Piana’s worst cured coating composition even though it does not contain an ingredient said by Piana to be essential and critical, and then to modify that worst cured coating composition to make applicant’s invention. Applicants accordingly request withdrawal of the §103(a) rejection of claims 1, 2, 4, 8, 10, 13 to 15, 19 to 23, 27, 31, 33, 36 and 37 over Piana.

Objection to Claims 28, 32, 34 and 35

Claims 28, 32, 34 and 35 have been rewritten in independent form including all of the limitations of the base claim and any intervening claims and thus should be allowable.

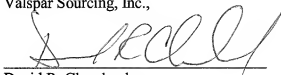
Conclusion

Applicants have made an earnest effort to address the rejections. Withdrawal of the Final Rejection and passage of the application to the issue branch are accordingly requested. The Examiner is encouraged to telephone the undersigned attorney if there any questions regarding the application or this amendment.

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